

Appl. No. 10/777,611
Amdt. Dated 01/27/2005
Reply to Office action of 11/30/2004

REMARKS/ARGUMENTS

Claims 1-30 are pending in the present application.

This Amendment is in response to the Office Action mailed November 30, 2004. In the Office Action, the Examiner rejected claims 1-30 under 35 U.S.C. §112; and claims 1-9, 11-19, 21-29 under 35 U.S.C. §103(a). In addition, the Examiner indicated allowable subject matter for claims 10, 20, and 30 if they are rewritten in independent form including all of the limitations of the base claim and any intervening claims. Reconsideration in light of the remarks made herein is respectfully requested.

Double Patenting

1. The Examiner rejects claims 1-30 under the judicially created doctrine of the obviousness-type double patenting of the claim in United States Patent No. 6,718,407.

Applicant has submitted a terminal disclaimer to obviate the obviousness-type double patenting rejection. Accordingly, Applicant respectfully requests the obviousness-type double patenting rejection of claims 1-30 be withdrawn.

Rejection Under 35 U.S.C. § 103

2. In the Office Action, the Examiner rejected claims 1, 11, and 21 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,805,882 issued to Cooper et al. ("Cooper") in view of U.S. Patent No. 5,606,660 issued to Estakhri et al. ("Estakhri"); and claims 2-9, 12-19, and 22-29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Cooper in view of Estakhri and further in view of U.S. Patent No. 6,266,810 issued to Tanaka et al. ("Tanaka"). Applicant respectfully traverses the rejection and contend that the Examiner has not met the burden of establishing a prima facie case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP §2143, p. 2100-129 (8th Ed., Rev. 2, May 2004)*.

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Applicants respectfully contend that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

Cooper discloses a computer system and method for replacing obsolete or corrupt boot code contained within a flash ROM. The flash ROM is connected to a mobile super I/O (MSIO) chip and the MSIO is connected to a system controller (Cooper, col. 5, lines 29-31).

Estakhri discloses a method and apparatus for combining controller firmware storage and controller logic in a mass storage system. A controller 300 includes a buffer 310 through which data or firmware code is transferred bi-directionally between flash memory 200 and host system 400 through a PCMCIA interface (Estakhri, col. 3, lines 17-21). A ROM 330 contains primitive microprocessor code for downloading firmware from flash sectors 200 to RAM 320 in addition to code for checking the integrity of the downloaded code (Estakhri, col. 3, lines 28-32).

Tanaka discloses a remote program downloading system and apparatus. A program acquiring means reads a packet into a buffer memory (Tanaka, col. 6, lines 14-19). A program storing means stores only the program main body into a flash ROM on the basis of the information in the buffer (Tanaka, col. 6, lines 20-24).

Cooper, Estakhri and Tanaka, taken alone or in any combination, does not disclose, suggest, or render obvious (1) receiving programming information to update a firmware device containing a boot code for a processor in a chipset separated from the processor from a communication interface, and (2) parsing the programming information into control commands and program data by a parser. There is no motivation to combine Cooper, Estakhri and Tanaka because none of them addresses the problem of updating a firmware device in a chipset separated from the processor. There is no teaching or suggestion that a chipset separated from the processor is present. Cooper merely discloses replacing obsolete boot code. Cooper does not disclose a chipset. Estakhri merely discloses a ROM containing a microprocessor code. A ROM is not capable of being updated. Furthermore, Estakhri does not disclose or suggest that the ROM or the flash sectors 200 contains a boot code. Tanaka merely disclosed a buffer memory storing address and size information, not actual program data. Cooper, read as a whole, does not suggest the desirability of updating a boot code in a chipset.

The Examiner failed to establish a *prima facie* case of obviousness and failed to show there is teaching, suggestion or motivation to combine the references. "When determining the

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patentability of a claimed invention which combined two known elements, 'the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ (BNA) 481, 488 (Fed. Cir. 1984). To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. Interconnect Planning Corp. v. Feil, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973. (Bd.Pat.App.&Inter. 1985).

In the present invention, the cited references do not expressly or implicitly suggest updating a boot code in a chipset. In addition, the Examiner failed to present a convincing line of reasoning as to why a combination of Cooper, Estakhri and Tanaka is an obvious application of self-updating a firmware device in a chipset separated from the processor.

Therefore, Applicant believes that independent claims 1, 11, 21 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §103(a) be withdrawn.

Allowable Subject Matter

3. Applicant notes with appreciation the Examiner's indication of allowable subject matter. The Examiner objects to claims 10, 20, and 30 as being dependent on a rejected base claim, but indicates that the claims would be allowable if rewritten in independent form including all of the

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limitations of the basic claim and any intervening claims. However, in light of the above remarks, Applicant respectfully requests that independent claims 1, 11, and 21, and all claims that depend therefrom be allowed.

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Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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01/27/2005

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